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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,426	07/03/2001	Masaaki Nanaumi	107348-00127	8333

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EXAMINER

CREPEAU, JONATHAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/897,426

Applicant(s)

NANAUMI ET AL.

Examiner

Jonathan S. Crepeau

Art Unit

1746

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 5-8

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Bruce Bell
BRUCE F. BELL
PRIMARY EXAMINER
GROUP 1746

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments are not persuasive in overcoming the outstanding rejection. Applicants assert that "Sockza-Guth specifically teach that 'the usability of non-perfluorinated materials is frequently still disputed in the current literature'" and that "it would not have been obvious to one of skill in the art, that non-perfluorinated materials, such as those specifically used only for membranes in the teachings of Sockza-Guth, could also have been 'usable' in electrodes." However, the statement questioning the usability of non-perfluorinated materials is made in the background section of Sockza-Guth, and the inventive material (sPEEK) is in fact non-perfluorinated. Thus, the statement in the background section is not believed to be a sufficient "teaching away" from using non-perfluorinated materials in the electrodes of Sockza-Guth.

Furthermore, Applicants assert that all the relevant examples in Cavalca et al., the secondary reference, "appear to be directed to fluorinated polymers." However, it is submitted that, while examples are helpful in interpreting or analyzing a reference, an artisan is not bound by such examples when considering the teachings of the reference. The teachings in paragraph 124 of Cavalca et al. may be viewed as general teachings regarding the applicability of an ionically conductive polymer in any fuel cell electrode. While fluorinated polymers are a "preferred embodiment" for the membrane, the reference teaches that "similar ionomers such as, for example, FLEMION® (Asahi Glass) can also be used" (paragraph 130). Thus, the disclosure of Cavalca is not limited to fluorinated polymers. Therefore, Applicant's assertion that "there is no suggestion in the art that the inclusion of non-fluorinated polymers in electrodes would work" is not persuasive because it is believed that Cavalca et al. provide such a suggestion by virtue of their teachings regarding "ionically conductive polymers" which are not limited to fluoropolymers.